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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/837,459 04/18/97 MCKEE

M 4995.0023

EXAMINER

HM12/0407

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PORTNER, V

ART UNIT

PAPER NUMBER

1641

DATE MAILED:

04/07/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/837,459

Applicant(s)

Mckee et al

Examiner

Portner

Group Art Unit

1641



☒ Responsive to communication(s) filed on Mar 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) 1-27 and 33-50 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 28-32 and 51-55 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Claims 1-55 are pending.

***Response to Amendment***

1. The reply filed on March 1, 1999 is not fully responsive to the prior Office action because of the following omission(s) or matter(s): The claims as amended now recite at least three distinct species of invention, wherein Claim 28 previously recited a genus claim and claim 29, which recites the term EHEC is set forth in such a way as to clarify the composition of claim 28, which generically claims anti-intimin antibodies which are free of other antibodies for an intimin expressing host bacteria (claim 28) and free of other antibodies specific for EHEC; the generic claims as previously presented were to compositions which would specifically bind to EHEC. The claims as now amended recite other species of antibodies and is no longer a generic claim as originally presented, wherein the compositions now comprise antibodies to EHEC or EPEC or the combination of antibodies to EHEC and EPEC (claim 28) or an antibody which specifically binds to a common epitope (monoclonal antibody, claim 30) which have the functional characteristic of blocking binding to either or both of these types of E.coli or may specifically bind to both but need not block binding (claim 51). Therefore, the claims as presented on Amendment, now recite distinct compositions with distinct binding characteristics which define distinct species of invention which were not previously represented in the claims. On this basis See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which

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to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

*Election/Restriction*

2. Newly submitted claims 28-32 and 51-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims as amended now recite three species of invention, wherein Claim 28 previously recited a genus claim and claim 29, which recites the term EHEC is set forth in such a way as to clarify the composition of claim 28, which generically claims anti-intimin antibodies which are free of other antibodies for an intimin expressing host bacteria (claim 28) and free of other antibodies specific for EHEC; the generic claims as previously presented were to compositions which would specifically bind to EHEC. The claims as now amended recite other species of antibodies and is no longer a generic claim as originally presented, wherein the compositions now comprise antibodies to EHEC or EPEC or the combination of antibodies to EHEC and EPEC (claim 28) or an antibody which specifically binds to a common epitope (monoclonal antibody, claim 30) which have the functional characteristic of blocking binding to either or both of these types of E.coli or may specifically bind to both but need not block binding (claim 51). Therefore, the claims as presented on Amendment, now recite distinct compositions with distinct binding characteristics which define distinct species of invention which were not previously represented in the claims

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 28-32 and 51-55 are withdrawn from consideration, in so far as they recite and are directed to a non-elected invention, specifically Species II and III listed below. See 37 CFR 1.142(b) and MPEP § 821.03.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

I: Compositions of antibodies which are free of other antibodies for an intimin expressing host bacteria and are free of other antibodies specific for **EHEC**(original claims 28-32)

II: Compositions of antibodies which are free of other antibodies for an intimin expressing host bacteria and specifically bind to and block or partially block **EPEC**(Amended claims 28-32).

III: Compositions of antibodies which are free of other antibodies for an intimin expressing host bacteria and specifically **bind to both EPEC and EHEC** and may or may not block or partially block binding to a mammalian cell.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

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4. Applicant should cancel claims 51-55 as they are drawn to a new invention and amend claim 28 to incorporate the limitations of originally presented claim 29.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this group is (703) 308-4242.

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The Group and/or Art Unit location of your application in the PTO will be changing February 7, 1998. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art 1641.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

April 6, 1999

*Christopher L. Chin*

CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800 / 641